

REMARKS

Claims 82 to 87 and 89 to 112 are in this case.

Applicant and his attorney held an interview with the Examiner on March 31, 2004. The substance of the interview is set forth below. First, Applicant agrees with the Examiner's "Interview Summary" dated 31 March 2004. Applicant provided the Examiner with a draft declaration of the Applicant Correa, but the Examiner indicated that the claims were allowable before the substance of the declaration was discussed. At the end of the interview Applicant's attorney asked the Examiner if the declaration should be filed as a part of this summary of the interview and the Examiner made it clear that it should not be filed.

The arguments given by Applicant's attorney, in support of allowance of the claims, follows:

Claim 82, has been amended to make it clearer that the reply envelope is "removable from said outgoing envelope and when so removed is totally separate from said outgoing envelope" ***. In contrast Bowen and Elminger have a single envelope that serves as both the outgoing and reply envelopes.

Claim 83 depends from claim 82 and specifies where the barcode is placed on an envelope, and hence is patentable.

Claim 84 depends from claim 83 and recites that both the outgoing and reply envelopes are positioned as claimed and this is patentable.

Claims 85 and 86 also depend from claim 82 and refers to which of four weights that the several parts have.

This is not a mere selection of a proper weight for a

problem. It is a selection of which parts of the envelope system should have one of four weights. This claim is therefore patentable.

Claim 87, is patentable since the amendment in lines 16-19 of the claim, in combination with the other elements, is new and non-obvious.

Claim 89, has been amended to add more detail to the reinforcing step and this renders the claim patentable. The Examiner has not cited any reference that shows how the reading machines damage the envelope.

Claim 90 has been amended to make it clear that the reply envelope is "removable from said outgoing envelope and when so removed is totally separate" etc. and thus, when read in combination with the other elements, distinguishes over the art of record.

Claim 91 calls for a tear strip, and its equivalents, when it calls for "means adjacent said lower end, for opening said envelope." The claim also says that the flap on the reply envelope is "closely adjacent said means when the reply envelope is in the outgoing envelope." The claim is therefore patentable.

When the flap on an outgoing/and/or reply envelope is located at the upper end of the envelope there is considerably reduced printing space available for printing information on the envelope. When the flap is located at the bottom there is a significant increase in usable printing area.

Claim 92 depends from claim 91, and limits the "means" clause of claim 91 to a tear strip.

Claim 93, calls for a novel arrangement that permits printing

the customer's address "near said upper edge" of the reply envelope. The prior art (cited against claim 93) does not even have a removable reply envelope. Hence, this claim produces a new and unexpected result, namely a removable reply envelope that has the customer's address printed near the upper edge at the same time that the customer's address is printed on the cover sheet.

Claim 94 depends from claim 93, and provides for the printing of the customer's name on the billing statement via a carbonized area. The references relied on by the Examiner for rejecting this claim do not have a printed removable reply envelope much less also a billing statement. While a removable reply envelope plus a billing statement is old, the overall combination of this claim is patentable.

Claim 95 is patentable since it depends from claim 91 and also defines the "means" in more detail and also defines the direction that the outgoing envelope passes through the postal service's processing machinery.

Claim 96 defines over the prior art in the last seven lines of the claim. The Examiner suggested that as a formal matter, the last seven lines be all one clause instead of two separate ones and this has been done.

Claim 97, calls for a removable reply envelope and therefore distinguishes from the references.

None of the references, relied on by the Examiner, teach how to print the required addresses on all of the cover sheets, the outgoing envelope and the reply envelope. This invention presents an entirely different problem from that of the references. In the

references that the Examiner cited against the claims, there is just one envelope which acts as both the outgoing and reply envelopes.

Claim 98 depends from claim 97, and recites the positioning of the barcode. The prior art does not recognize that there is a problem involving the position of a barcode.

Claim 99, depends from claim 93 and calls for printing a FIM mark on the removable reply envelope. The references cited by the Examiner do not teach how to print a FIM mark on a removable reply envelope.

Claim 100 has been amended to define over the references cited against it by reciting that the reply envelope is removable, etc. This claim teaches how to print the names of the sender and of the addressee on the removable reply envelope. The Examiner does not show how the references can be combined to teach this result. In addition the references do not also teach how to print a FIM mark on a removable reply envelope.

Claim 101 depends from claim 100 and also calls for printing the addresses on the outgoing envelope. Thus, this claim involves printing two addresses on each envelope, one of which envelopes is removable.

Claims 102 and 103 are patentable since none of the Examiner's references recognized the problem. The problem is that ultra-sensitive reading machines are often confused by printing on the contents of the envelope. The machine can see through ordinary envelopes and see data on the letter, check, etc. in the envelope. The reading machines are not one or more elements of these claims since these claims define a new envelope per se. This new envelope

has the advantage over prior art envelopes in that they do not confuse the reading machines of the U.S. Postal Service.

Claim 102 defines envelopes with opaque areas and security screening elsewhere. This renders the claim patentable.

Claim 104 calls for printing names and addresses on both an outgoing envelope and a two-part billing sheet. This is new and patentable over the references relied on by the Examiner.

Claims 105 and 106 depend from claim 82 and define more details of the removable reply envelope. This adds patentability to claim 82.

Claim 107 depends from claim 82 and teaches an arrangement that enables printing of information on all three of the (1) originating sheet, (2) the outgoing envelope and (3) the removable reply envelope. The references cited by the Examiner do not teach Applicant's concept as claimed.

Claim 108 depends from claim 107 and calls for the relationship of the bottom edges of the outgoing and removable reply envelope. This makes the arrangement of claim 107 better for overall use of the product.

The Examiner said that claim 109 would be allowable if the word "dark" is added. This avoids a very thick white envelope. The modern ultra-sensitive reading machines are sometimes confused by printing on the contents of ordinary envelopes. The invention of claim 109 protects the printing on the outside of an envelope from such confusion. Claim 109 is for the envelope per se. The reading machine is not an element of this claim.

Claim 110 depends from claim 91, and defines the relation

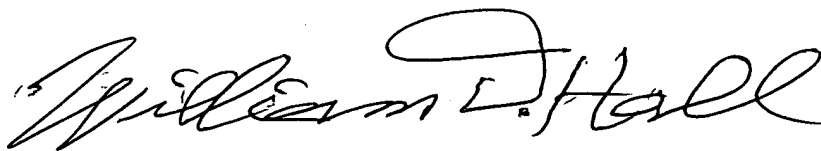
between said "means" and said "flap" on the one hand and the distance between said upper and lower ends. This relationship greatly improves the envelope system. When the flap on the outgoing/reply envelopes is located at the upper end of the envelope there is considerably reduced printing space available for printing on the envelope, when the flap is located at the bottom there is a significant increase in usable printing area. This increased area permits the return addresses for both envelopes to be printed, and also the printing of the mail to address to be printed on both envelopes. There is also a large gain of printable area in the description fields.

Claim 111 is patentable for the same reason as claim 110 except it refers to the "tear strip" instead of the broader "means".

Claim 112, depends from claim 82 and patentably defines the addresses in more detail.

None of the foregoing arguments is intended to make a post office reading machine an element of a claim unless the reading machine is positively recited as an element of the claim.

Respectfully submitted,

A handwritten signature in black ink, reading "William D. Hall". The signature is fluid and cursive, with a large, stylized initial "W".

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